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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,402	01/22/2004	Hajime Mizutani	U 014997-7	4538

7590

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EXAMINER

COLILLA, DANIEL JAMES

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 08/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/763,402	MIZUTANI ET AL.	
	Examiner	Art Unit	
	Daniel J. Colilla	2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004 and 20 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 July 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/20/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. Figure 7 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities: on page 14, line 5, it appears that "21b" should actually be --221b-- in order to consistently use reference signs throughout the specification.

Appropriate correction is required.

Claim Objections

3. Claims 5-9 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. These claims are directed towards a transfer pressure roll but applicant has not recited any limitations in these claims to further limit the transfer pressure roll.

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Instead applicant has recited structure of the recording matter or the transferable protection layer, structures which have not been positively recited as part of the claimed subject matter.

Claim Objections

4. Claim 1-11 are objected to because of the following informalities:

In claims, 1 and 10, it is not clear what is meant by "HA" in the term "HA 40 degrees."

In line 1 of claim 11, it appears that "a" should actually be --an--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 11, lines 1-5, the recitation regarding the recording sheet appears to be a double recitation of the recording matter recited in claim 10.

In claim 11, line 6, "a protection layer forming portion" and lines 6-10 of the claim appear to be a double recitation of the laminated sheet forming section recited in claim 10.

It is noted that later in claim 11, applicant recites that the protection layer forming portion is composed of the transfer unit according to claim 10. This language is awkward giving the

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appearance of a double recitation. Also it is not clear if applicant is intending to further limit the laminated sheet forming section by the recitation of the protection layer forming portion.

Appropriate correction is required.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No.

10/675,866. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of Application No. recites all the recited claim limitations of the transfer pressure roller in claim 1 of the present application.

Similarly claim 2 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of copending Application No. 10/675,866.

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Similarly claim 3 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of copending Application No. 10/675,866.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Kitagawa et al. (US 6,176,286).

With respect to claim 1, Kitagawa et al. discloses a transfer pressure roll 21A that has a cylindrical body and an elastic layer covering 23 which has a hardness of 500-580 JIS A-type as shown in Figure 1 and disclosed in col. 6, lines 49-65 of Kitagawa et al. Applicant may make reference to the GELTEC website printout which states that the hardness measurements JIS K6253 and JIS A are the same. It is noted that while applicant recites extensive limitations regarding the recording matter and transferable protection layer, these structures are not positively recited as part of the claimed subject matter.

With respect to claim 2, in col. 6, line 51 Kitagawa et al. discloses that the elastic layer material may be silicon rubber.

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With respect to claim 3, Kitagawa et al. discloses that the elastic layer 23 may have a thickness of 3 mm (col. 6, lines 61-62).

With respect to claim 4, Kitagawa et al. discloses that the pressure roll 21A may have a heater inside the roll body (col. 6, lines 54-55).

With respect to claims 5-9, applicant has not recited any additional structure of the transfer pressure roll, therefore these claims are rejected along with their parent claim, claim 1.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwata (US 2002/0005886) in view of Kitagawa et al. (US 6,176,286).

With respect to claim 10, Iwata discloses the claimed transfer device except for the elastic layer and the hardness of the elastic layer of the transfer pressure roll. Iwata discloses a transfer device including a laminated sheet forming section 3 which supplies an image protection film 1e having a supporting body 8b as shown in Figures 2 and 3 of Iwata. Further disclosed is a press section 6 which heat-pressurizes (Iwata, paragraph [0034]) the laminated sheet to attach the transferable protection layer 1e on the recorded image on the recording sheet 1b to form a laminated sheet 1a as shown in Figure 1 of Iwata. Also disclosed is a peeling-off section 10 which peels off the supporting body 8b as shown in Figure 2 of Iwata. The press section 6

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disclosed by Iwata includes an upper roll 6 which is a pressure member and a lower roll 6 which is a pressure reception member as shown in Figure 2 of Iwata. The pressure member 6 is a transfer pressure roll comprising a cylindrical roll body.

Kitagawa et al. discloses a transfer pressure roll 21A that has a cylindrical body and an elastic layer covering 23 which has a hardness of 500-580 JIS A-type as shown in Figure 1 and disclosed in col. 6, lines 49-65 of Kitagawa et al. Applicant may make reference to the GELTEC website printout which states that the hardness measurements JIS K6253 and JIS A are the same.

It would have been obvious to combine the teaching of Kitagawa et al. with the transfer device disclosed by Iwata for the advantage of the preparatory bonding rolls 20A and 20B which aid in lamination so that there are fewer wrinkles and less looseness in the final laminated product (Kitagawa et al., col. 3, lines 25-31). It is noted that while applicant recites limitations regarding the recording matter, the claim is directed towards a transfer device and the recording matter structure is not positively recited as part of the claimed subject matter.

With respect to claim 11, Iwata discloses that the transfer device is combined with an image recording apparatus 4 which is an ink jet recording portion (Iwata, col. 6, line 105) as shown in Figure 2 of Iwata. The protection layer forming portion, as mentioned above, appears to be a double recitation of the laminated sheet forming section which has been mentioned above with respect to claim 10. It is noted that while applicant recites limitations regarding the recording sheet, the claim is directed towards an image recording apparatus; the recording matter structure is not positively recited as part of the claimed subject matter.

Conclusion

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13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kawasaki is cited to show another example of a pressure roller with an elastic body and a hardness that can be 40 degrees or larger. Sawano is cited to show another example of an image forming apparatus with a pressure roller having a hardness that is higher than 40 degrees.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Colilla whose telephone number is 571-272-2157. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 571-272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 2, 2005



Daniel J. Colilla
Primary Examiner
Art Unit 2854